

# Notice of Allowability

Application No.

09/997,529

Examiner

Sandra Wegert

Applicant(s)

GODDARD ET AL.

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## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 5/2/07.
2. ☒ The allowed claim(s) is/are 122-126 and 129-131 (renumbered as 1-8).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.


Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.



EILEEN B. O'HARA  
PRIMARY EXAMINER

**DETAILED OFFICE ACTION**

The Appeal Brief of 2 May 2007 has been entered. Claims 1-121, 127 and 128 are cancelled.

Currently, claims 122-126 and 129-131 are pending and under consideration.

**Withdrawal of Objections and Rejections:**

The rejections of claims 122-126 and 129-131 under 35 U.S.C. 101 and 112, first paragraph, for lack of utility and enablement are withdrawn based on applicants' arguments and for the reasons listed below.

**Examiner's Statement of Reasons for Allowance**

The following is an examiner's statement of reasons for allowance:

Upon further consideration, the rejections of claims 122-126 and 129-131 under 35 U.S.C. § 101 and 112, first paragraph, for lack of utility and enablement are withdrawn for the following reasons: the claims are directed to the polypeptide of SEQ ID NO: 357, as well as polypeptides having at least 95-99% sequence identity to SEQ ID NO: 357. The specification discloses that the peptide of SEQ ID NO: 357 enhances the uptake of glucose and/or free fatty acids by adipocyte cells. Stimulation of glucose uptake by adipocytes is a fairly common way of testing pharmaceutical agents for treating diabetes (see, for example: Liu et al., J. Nutr. 2005, 135(2), pp. 165-171; Gowri et al., Metabolism, 1999, 48(4), pp. 411-414; Edens et al., J. Nutr. 2002, 132(6), pp. 1141-1148). Thus, the polypeptide of SEQ ID NO: 357 has a significant and

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presently available benefit to the public as a peptide useful for diabetes research. The Examiner does not have evidence specific to the claimed polypeptide to refute that.

Further, the prior art search results do not teach or fairly suggest the polypeptide of SEQ ID NO: 357, including polypeptides that are 95-99% homologous to SEQ ID NO: 357.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

**Conclusion:**

Claims 122-126 and 129-131 are allowed.

**Advisory information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Wegert whose telephone number is (571) 272-0895. The examiner can normally be reached Monday - Friday from 9:00 AM to 5:00 PM (Eastern Time). If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Manjunath Rao, can be reached at (571) 272-0939.

The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (in USA or CANADA) or 571-272-1000.

SLW

12 August 2007



EILEEN B. O'HARA  
PRIMARY EXAMINER